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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,511	11/30/2000	Hiroaki Ishizuka	197792US28	8903
22850	7590	09/08/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SNAPP, SANDRA S	
			ART UNIT	PAPER NUMBER

3624

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,511

Applicant(s)

ISHIZUKA, HIROAKI

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

This Office Action is in response to the Amendment filed 6-15-2004. Currently, claims 1-46 are pending in the application.

Specification

The amendment to the abstract submitted on 6-15-04 is acceptable and has been entered into the application.

Drawings

Again, the Applicant is reminded that this application lacks formal drawings and that they will be required to submit new formal drawings before the application can issue.

Claim Objections

The objection to claim 1 is herein withdrawn in view of the amended language submitted on 6-15-04.

Claim Rejections - 35 USC § 112

Claims 3, 7, 26 and 30 have been amended and successfully overcome the rejection based on 35 U.S.C. 112, second paragraph, as being indefinite, as such the rejection is herein withdrawn.

Claim Rejections - 35 USC § 102

Claims 1, 9-24 and 32-46 remain and are finally rejected under 35 U.S.C. 102(b) as being anticipated by the Mandler et al. patent (US 5,732,400).

The Mandler patent discloses a method, and associated means, of communicating, comprising:

Means for storing a customer's financial information in a supplier computer system based on an off-line transaction between a supplier and a customer (col. 3, lines 39-43), means for beginning an on-line purchase by the customer with a supplier and communicating to a server computer by the customer (col. 4, lines 20-24), means for determining that the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction (col. 4, lines 24-29), and means for communicating to the customer that the on-line purchase has been approved, after said determining step determines that the customer is an acceptable credit risk (col. 4, lines 34-42) (Claims 1 and 24);

Means for issuing a bill for the on-line purchase (col. 5, lines 1-5) (Claims 9 and 32);

Means for issuing an electronic bill for the on-line purchase (col. 11, lines 4-13) (Claims 10 and 33);

Means for transmitting the electronic bill for the on-line purchase by email (col. 11, lines 4-13) (Claims 11 and 34);

Means for notifying said customer by an electronic mail message that said electronic bill is stored at the Internet site (col. 11, lines 4-13 and col. 5, line 60 through col. 6, line 4) (Claims 12, 13, 35 and 36);

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Means for issuing a single electronic bill for both the on-line purchase and a lease corresponding to the off-line transaction (col. 11, lines 4-13) (Claims 14 and 37);

Means for printing a paper bill for the on-line purchase, and sending the paper bill to the customer (col. 11, lines 4-13) (Claims 15 and 38);

Means for debiting a pre-registered bank account by an amount corresponding to the on-line transaction (col. 11, lines 4-13) (Claims 16 and 39);

Means for debiting a pre-registered bank account by an amount corresponding to the on-line transaction and a payment for the off-line transaction (col. 11, lines 4-13) (Claims 17 and 40);

Means for charging a third party credit card of the customer for the on-line transaction (col. 2, lines 3-14) (Claims 18 and 41);

Means for issuing a paper bill for said transaction if said financial information is not valid (col. 11, lines 4-14) (Claims 19 and 42);

Means for issuing the bill for the on-line purchase according to a predetermined billing cycle which is greater than one day (col. 2, lines 47-50) (Claims 20 and 43);

Means for issuing a single bill for plural transactions occurring over a time period (col. 5, lines 6-17) (Claims 21 and 44); and

Means for purchasing a product through the on-line purchase, the product being different from a product obtained through the off-line transaction (col. 5, lines 6-17) (Claims 22 and 45); and

Means for purchasing the product through the on-line purchase which is for use with the product obtained through the off-line transaction (col. 5, lines 6-17) (Claims 23 and 46).

Claim Rejections - 35 USC § 103

Claims 2-8 and 25-31 remain and are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the Mandler et al. patent in view of the Bennett et al. patent application (US 2001/0039516 A1) and further in view of the Lussi patent application (US 2002/0065754 A1).

The Mandler patent discloses a method, and associated means, of communicating, comprising means for storing the customer's financial information based on a lease of an image forming device including that of a copier and a facsimile machine and up-to-date payments on the lease (col. 3, lines 39-43 and col. 4, lines 29-42) (Claims 2, 3, 4, 5, 6, 7, 25, 26, 27, 28, 29 and 30). Mandler discloses storing financial information based on a persons credit history, which inherently includes various types of goods and leases. Although Mandler doesn't specifically disclose a lease for an image forming device such as a copier and a facsimile machine, the Examiner reaffirms her taking of Official Notice that such goods would fall within the purview of the type of goods covered in standard credit reports which are used as a basis for the credit analysis in Mandler, especially for businesses. Also, the Bennett reference discloses that leases are viable financing (credit) information as evidenced wherein it states, "to obtain financing parameter information regarding one or more financing vehicles (such as, for example, loans, revolving credit, leases, etc." (Bennett, paragraph [0016]). And the Lussi patent discloses that it is common to "lease or buy bulk items, such as phone systems, furniture, copy machines, construction office of office space, etc." Hence, it is would have been obvious to one of ordinary skill in the art to have modified the Mandler patent to include the teachings of the Bennett and

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Lussi patent so as to provide an true and accurate credit history of the user buy including any leases they may have.

The Mandler patent discloses a method, and associated means, of communicating, comprising means for communicating that the on-line purchase which is a purchase of supplies for an image forming device which has been obtained through the off-line transaction has been approved (col. 4, lines 29-42) (Claims 8 and 31). Mandler discloses communicating the transaction approval, just not that it was for the purchase of supplies for an image forming device. The types of goods purchased are merely descriptive, and since Mandler pertains to any type of goods purchases, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the purchase of supplies for an image forming device within the type of goods purchased in the Mandler invention. The Examiner takes Official Notice that the specific types of goods in the present application are a foreseeable good as anticipated by Mandler.

Response to Arguments

The Applicant asserts the Mandler reference does not show a system wherein the customer's financial information is stored in a supplier's computer system based on an off-line transaction between a customer and a supplier. It is the Examiner's position that the type of transaction, either off-line or on-line, is merely intended use of the system. In other words, the system would still operate the same whatever type of transaction is used, be it off-line or on-line, and as such no patentable weight is given to the transaction being off-line.

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Applicant further states that since the Mandler patent discloses a system that “provides for enabling on-line transactional services among sellers and buyers having no previous relationship with each other” that the Mandler system is clearly different from the presently claimed invention. While Mandler may provide for transactions between buyers and sellers having no previous relationship, it still discloses all the elements of the presently claimed invention and can be used with buyers and sellers having previous relationships also. Also, Mandler states, “in corporate-to-corporate transactions between major trading partners, such as two large corporations well-known to each other, the practice of selling party providing credit, or trade terms, to the buyer, is firmly embedded in tradition and creates strong relationships between such major trading partners.” (Mandler, col. 1, lines 23-28). As such, Mandler anticipates the present invention.

The Applicant has also challenged the Examiner’s Official Notice that a lease for an imaging forming device such as a copier and a fax machine are goods that would fall within the purview of the types of goods covered in a standard credit report. The Examiner has cited the Bennet and Lussi patent applications to illustrate that such concepts are well known.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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